

REMARKS

Claims 1, 3 and 6-13 are pending and await action on the merits. Claims 2 and 4-5 have been canceled without prejudice.

Claim 1 has been amended to recite the subject matter of canceled claims 2 and 4-5. Also, claim 1 has been amended to recite that the hollow microparticle has a shell and a cavity formed inside the shell, wherein the cavity is completely enclosed by the shell. Support for this description can be found in paragraph [0089].

The dependency of claims 3 and 6-9 has been modified.

Claim 7 has been amended to recite that the conductive microparticles are "electrically" conductive microparticles. It is clear from paragraph [0046] relating to the antistatic function that the conductive microparticles impart to the polarizing plate protective film that the conductive microparticles of claim 7 are "electrically" conductive microparticles.

Support for new claims 11-13 can be found in claims 8-10.

No new matter has been added by way of the above-amendment.

Response to Rejection under 35 U.S.C. § 112

The Examiner has rejected claim 7 under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicants respectfully traverse the rejection.

Specifically, the Examiner states that the claim contains the limitation that the microparticles are conductive but does not specify the type of conductivity (thermal, electrical, etc.).

As mentioned above, claim 7 has been amended to recite that the conductive microparticles are "electrically" conductive microparticles. It is clear from paragraph [0046] relating to the antistatic function that the conductive microparticles impart to the polarizing plate

protective film that the conductive microparticles of claim 7 are "electrically" conductive microparticles.

As such, the currently amended claims particularly point out and distinctly claim the subject matter which Applicants regard as the invention. As such, withdrawal of the rejection is respectfully requested.

Response to Rejections over the Prior Art

The following Rejections are pending:

- 1) Claims 1-7 are rejected under 35 U.S.C. § 102(b) as being anticipated by Shoshi et al. '188 (U.S. 2003/0104188);
- 2) Claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Shoshi et al. '188 in view of Murakami et al. '900 (U.S. 5,681,900); and
- 3) Claims 9-10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Shoshi et al. '188 in view of Nakamura et al. '929 (U.S. 2001/0035929).

Applicants respectfully traverse Rejections 1-3.

In order to further distinguish from the cited references, Applicants have amended claim 1 to recite that the polarizing plate protective film comprises a low-refractive-index layer including a hollow microparticle having a shell and a cavity formed inside the shell, wherein the cavity is completely enclosed by the shell.

It is clear from the Examiner's comments regarding the teachings of Shoshi et al. '188 that Shoshi et al. '188 teach a polarizing plate protective film, wherein the layer that the Examiner equates with the inventive low-refractive-index layer includes a hollow microparticle which is porous and is not formed of a cavity completely enclosed by a shell, as presently claimed.

As the MPEP directs, all the claim limitations must be taught or suggested by the prior art to establish a *prima facie* case of anticipation or obviousness. See MPEP §§ 2131 and 2143.03. In view of the fact that Shoshi et al. '188 (either taken alone or in combination with Murakami et al. '900 and/or Nakamura et al. '929) fail to teach or fairly suggest a polarizing plate protective film which comprises a low-refractive-index layer including a hollow microparticle having a

shell and a cavity formed inside the shell, wherein the cavity is completely enclosed by the shell,
a *prima facie* case of anticipation or obviousness cannot be said to exist.

As such, withdrawal of Rejections 1-3 is respectfully requested.

Furthermore, Applicants respectfully submit that even if a *prima facie* case of obviousness were to exist, which it does not, the inventive polarizing plate protective film which comprises a low-refractive-index layer including a hollow microparticle having a shell and a cavity formed inside the shell, wherein the cavity is completely enclosed by the shell, has unexpectedly superior properties when compared to polarizing plate protective films which comprise a low-refractive-index layer including a porous microparticles as disclosed by Shoshi et al. '188. In support of this position, Applicants enclose an unexecuted Declaration under 37 CFR 1.132 (it is planned to have the executed Declaration follow shortly). As such, even assuming *arguendo* that a *prima facie* case of obviousness were to exist, which it does not, the inventive low-refractive-index layer including a hollow microparticle having a shell and a cavity formed inside the shell, wherein the cavity is completely enclosed by the shell, gives the polarizing plate protective film unexpected properties over the polarizing plate protective film of Shoshi et al. '188 and as such, the present invention is not obvious. Again, withdrawal of Rejections 1-3 is respectfully requested.

Response to Obviousness-Type Double Patenting Rejections

A) The Examiner has rejected claims 1-4, 6 and 8 under the doctrine of obviousness-type double patenting over claims 1 and 5-8 of U.S. Patent No. 7,285,323. Applicants respectfully traverse the rejection.

The Examiner will note that the above-amendment to the claims has reduced the overlap in the explicitly recited limitations. For example, inventive claim 1 now recites that the hard coating layer includes an activated energy ray-curable resin or a heat-curable resin. In view of the fact that the claims of U.S. Patent No. 7,285,323 do not explicitly recite this feature, the obviousness-type double patenting rejection is not proper without a secondary reference to teach this feature. As such, withdrawal of the rejection is respectfully requested.

B) The Examiner has provisionally rejected claims 1-4 under the doctrine of obviousness-type double patenting over claims 1 and 6 of co-pending Application No. 11/628,844. Applicants respectfully traverse the rejection.

The Examiner will note that the above-amendment to the claims has reduced the overlap in the explicitly recited limitations. For example, inventive claim 1 now recites that the hard coating layer includes an activated energy ray-curable resin or a heat-curable resin. In view of the fact that the claims of co-pending Application No. 11/628,844 do not explicitly recite this feature, the provisional obviousness-type double patenting rejection is not proper without a secondary reference to teach this feature. As such, withdrawal of the rejection is respectfully requested.

C) The Examiner has provisionally rejected claims 1-4, 6 and 8 under the doctrine of obviousness-type double patenting over claims 1-13 of co-pending Application No. 11/793,762. Applicants respectfully traverse the rejection.

The Examiner will note that the above-amendment to the claims has reduced the overlap in the explicitly recited limitations. For example, inventive claim 1 now recites that the hard coating layer includes an activated energy ray-curable resin or a heat-curable resin. In view of the fact that the claims of co-pending Application No. 11/793,762 do not explicitly recite this feature, the provisional obviousness-type double patenting rejection is not proper without a secondary reference to teach this feature. As such, withdrawal of the rejection is respectfully requested.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Garth M. Dahlen, Reg. No. 43,575

Application No. 10/584,412
Amendment dated July 11, 2008
Reply to Office Action of February 11, 2008

Docket No.: 4252-0120PUS1

at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.147; particularly, extension of time fees.

Dated: July 11, 2008

Respectfully submitted,

By 

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Attached: Unexecuted Declaration